

REMARKS/ARGUMENTS

This response is submitted in response to the Office Action dated November 11, 2006. Reconsideration and allowance is requested.

Claims 60-65 remain in this application. Claims 1-59 were previously canceled.

Claim Rejection under 35 USC 101

In the Office Action, claims 60-65 were rejected under 35 USC 101, as being directed to non-statutory subject matter. The Examiner argued that

the claims fail to include transformations from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely measuring would not appear to be sufficient to constitute a tangible result, since the outcome of the measuring step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized.

Counsel for assignee does not agree that the claims do not set forth a practical application because the preamble recites that the claim is a method for measuring film thickness. Moreover, counsel for assignee believes that claims recite a tangible result as specified in MPEP 2106. According to MPEP 2106:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing...see also *Corning*, 56 U.S. (15 How) at 268 14 L.Ed. 683 ("It is for the discover or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted...")

Since the claims describe a method for measuring film thickness, which is a practical method or means of producing a beneficial result or effect (i.e. measuring a film thickness), counsel believes that that the claims are tangible. Nevertheless in an effort to expedite prosecution, independent claims 60-65 have been amended to recite that the irradiated

light is emitted from a light source and passed through a lens and that the detected light is passed through a lens with a sensor. Claims 60-65 have also been amended to recite that the wafer is moved so as to successively place the measuring points in an optical field of the lens. Counsel believes that claims 60-65 set forth a practical application that produces a real-world result and that these claims are allowable. Counsel for assignee respectfully requests that the Examiner reconsider the claims in light of these amendments and remarks.

Claim Rejection under 35 USC 112

In the Office Action, claim 60 was rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 60 was rejected because the "variable 'n' is defined in the specification as the refractive index, however it is not defined in the claim." Claim 60 has been amended to delete the reference to 'n'.

Double Patenting Rejection

Claims 14-29 were rejected on the grounds of nonstatutory double patenting based on the judicially created doctrine of obviousness-type double patenting over claims 3-6 of U.S. Patent No. 7,119,908. Counsel for assignee includes a terminal disclaimer to overcome this rejection.

Claim Rejection under 35 USC 102

In the Office Action, claims 60-65 were rejected under 35 USC 102(e), as being anticipated by Nomoto et al. (U.S. Patent No. 7,119,908). Counsel for assignee respectfully traverses. "Under 35 USC § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference..." *Akzo v. N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) cert. denied, 482 U.S. 909 (1987).

The Examiner argued that Nomoto et al shows "determining plural measurement points on said wafer by frequency analysis or fitting for measuring the film thickness (first clause); and measuring the film thickness at the measurement points. Nomoto et al do not expressly state that the measurement points are successively irradiated; however, this would be

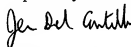
an inherent step as light must be irradiated onto each measurement point." Counsel for assignee does not agree that Nomoto teaches each and every element of the claimed invention. For example, the Examiner has not shown where Nomoto teaches "determining plural measurement points on said wafer by frequency analysis or fitting for measuring the film thickness." Nevertheless in an effort to expedite prosecution, independent claim 60 has been amended so that claims 60-65 are further distinguishable over Nomoto.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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